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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,976	07/09/2002	Tracey Cooke	P/3610-27	6221

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EXAMINER	
FORD, JOHN M	

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/049976	Cooke et al
Examiner	**Group Art Unit**
T M Foul	1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1 - - 8 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 - - 8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

This is a 371 of PCT/EP00/08143, filed 08/09/2000. Content in 371 applications is governed by 37 CFR 1.475 A product and a specific utility.

Claim 1 speaks to fungicides, yet claim 5 speaks to pesticidal. Applicants need to pick one, per Rule 475.

The expression "at least one" in claims 5 and 6 is "open". "One or more" is suggested.

Claim 1 violates 35 U.S.C. 101 and 35 U.S.C. 112, since it is drafted in terms of use. See Clinical Products vs. Brenner, 255 F. Supp. 151; 149 USPQ 475 (D.C. District Columbia 1966).

Claim 1 is not a proper method claim, in this country.

Claim 1 is rejected under 35 USC 112, 2nd paragraph. Substituted is used throughout the claim without indicating what the substituents are.

The Supreme Court in 1928 in Corona vs. Dovan 1928 USSC; 1928 C.D. 253, objected to the open breadth of "substituted"; 276 U.S. 358.

Note A^1, we know one of the 4 substituents.

Claim 1 is rejected under 35 U.S.C. 112, 2nd and 1st paragraph.

What is the heterocyclic in A^2 and A^3, and where is it supported.

Applicants are asking the reader to conceive of every possible heterocyclyl and classify, and search them, when they have not been shown to exist.

Assuming that applicant is claiming what he regards as his invention, there are in reality only two basic reasons for rejecting claims under 35 U.S.C. 112; first is that language used is not precise enough to provide a clear-cut indication of the scope of the

subject matter embraced by claim; this ground finds its basis in second paragraph of section 112; second is that language is so broad that it causes the claim to have a potential scope of protection beyond that which is justified by specification disclosure; this ground stems from the first paragraph of section 112; merits of language in claim must be tested in light of these two requirements.

The heterocyclic variable is not precise and definite enough to provide a clear-cut indication of the scope of the subject matter embraced by the claim. The heterocyclic concept is so broad that it causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure.

The written description is considered inadequate here in the specification. Conception should not be the role the reader. Applicants should, in return for a 17/20-year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35 U.S.C. 112, first and second paragraph reject. If you (the Public) find that it works, I claim it, is not a proper basis for patentability, In re Kirk, 153 U.S.P.Q 48 page 53.

The heterocyclic rings possible is wide open to staggering possibilities.

Applicants place too much conception with the reader. The heterocyclic expression leaves open, which ones: Azines, Diazines, Triazines, Tetrazines. Where are the starting materials in the specification?

Conception of what the intended heterocyclic ring, may be, should not be left to the reader.

One needs to know exactly where, in the ring, the hetero atoms are: 1, 2 or 1, 3 or 1, 4 or 1, 2 4 or 1, 3, 4, etc, (7 membered rings) as each is a different entity, with a separate search.

These are compound claims; one must clearly know what is being claimed.

One, on reading the indication of heterocyclyl applied by applicant, has no idea where the heteroatoms are in this unknown ring.

Not all heterocyclic rings have been shown to be producible, as stable, at room temperature. What is the source of the starting materials? Where is the adequate representative exemplification in the specification to support the claim language?

The heterocyclic term presents a problem of lack of clear claiming, and support in the specification for the variables sought.

This rests specific conception with the reader.

What exactly is intended, and where is that supported in the specific conception with reader. Not a fair burden in return for applicants receiving a 17/20-year monopoly.

A Markush listing of intended, conceived of, producible heterocyclic rings is what is needed here. It is not possible to classify and search the molecule, unless one knows exactly which heterocyclic ring is being claimed.

The ultimate utility here is fungicidal. Declarations of unexpected results are often presented in this art. Applicant's breadth of heterocyclic produces many different heterocyclic rings that could easily affect results.

Applicants need to claim what they have demonstrated as a specific fact.

The heterocyclic expression in claim 1 is not acceptable as it does not indicate, exactly, clearly, and specifically, what heterocyclic ring is being claimed. This expression rests specific conception with the reader, and the specification does not include the source of the starting material for the rings which applicant now claims. One must be able to tell from a simple reading of the claim, what it does and not encompass.

Why? Because that claim precludes others from making, using, or selling that compound for 17/20 years. Therefore, one must know what is being claimed.

The claims measure the invention, United Carbon Co. vs. Binney and Smith Co; 55 U.S.P.Q. 381 at 384, col. 1, end of first paragraph, Supreme Court of the United States (1942).

The U.S. Court of Claims held to this standard in Lockhead Aircraft Corp. vs. United States, 193 U.S.P.Q. 449, "claims measure the invention and resolution of invention must be based on what is claimed".

The CCPA in 1978 held " that invention is the subject matter defined by the claims submitted by the applicant". "We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 U.S.P.Q. 11, at 15.

The claim cannot be completely searched, here, until we know what applicant feels heterocyclic means.

The USPTO only recognizes: C, N, O, S, Se, or Te as atoms of a heterocyclic ring. Therefore, there is a need for applicants to indicate what they mean by heterocyclic.

Heterocyclic is not just a substituent; it is a whole body of art. Researchers often spend their entire life on hetero N heterocy - clic compounds without ever getting to hetero O or hetero S compounds. Many heterocyclic compounds, within the claim, have never been made.

Accordingly, claim 1 is rejected under 35 U.S.C. 112, 1 and 2nd paragraphs. What is being claimed? Where is the adequate representative exemplification in the specification?

Heterocyclic means many different things to different people. Some definitions of heterocyclic include B, P and As as heteroatoms. The U.S.P.T.O. does not consider those heterocyclic, and does not classify those patents as hetero rings. What applicants intend need be found in the claim.

The specification serves various purposes, it sets forth the prior art, that which applicants found unsuccessful, a defensive publication, that which applicants decided not to claim, or compounds that step the infection, but kill the patient. The reader cannot tell the extent of the new invention, unless it is clearly set forth in the claims, out of the mixed pieces of information of the specification. The claims have to clearly set out that which is claimed.

The heterocyclic term is not acceptable, as it reads on heterocyclic rings that require specific conception by the reader. Specific, producible, heterocyclic rings are not set forth in the claims. The source of the starting materials for the combinations claimed is not set forth.

Exactly what ring is being claimed, must be set forth in the claim.

Conception of what the intended heterocyclic ring, may be, should not be left to the reader.

Where is, what is intended by applicant, supported in the specification with sufficient representative exemplification? Note United Carbon Co. vs. Binney Smith Co. 55 U.S.P.Q. 381, Supreme Court of the United States (1942) " an invention must be capable of accurate definition, and it must be accurately defined to be patentable," above at 386.

Claims 2---8, 29 are rejected as being dependent or a rejected claim.

In regard to claim 5, pesticidal reads on insects, deer and ground hogs.

This requirement of one specific utility is consistent with Unity of Invention Practice in International Applications and National Phase Applications under U.S.C. 371, and PCT Rule 13.2 for PCT applicants, and the above noted.

Therefore, applicants should limit the method claims to a "specific utility".

Examples of utility expressions that have been held to be insufficient are:

A disclosure that the claimed compounds can be used for "technical and pharmaceutical purpose" does to meet the requirements of 35 U.S.C. 112. In re Kirk et al. (CCPA 1967) 376 F2d 936, 153 USPQ 48. Same ; « good effects against a very wide range of insects ». In re Lorenz et al. (CCPA 1962) 305 F2d 875, 134 USPQ 312.

Therefore, claim 5 should be cancelled, as restricted out per Rule 475.

Claims 2 and 3 need "an effective amount of" clause.

"At least one" in claim 6 is open. One or more---is suggested.

Claim 7 is rejected for the reasons claim 1 was/is.

JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624

J. M. Ford:tgd

December 15, 2003